



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,727	08/28/2001	Donald W. Landry	51400-B/JPW/AJM/MML	6766

7590

03/03/2003

John P. White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

PATTERSON, CHARLES L JR

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,727

Applicant(s)

LANDRY, DONALD W.

Examiner

Charles L. Patterson, Jr.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,21 and 41-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1,21 and 41-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Art Unit: 1652

Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1, 21 and 43-44, drawn to a catalytic antibody for degrading cocaine, classified in class 435, subclass 188.5.
- II. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 3B9, classified in class 536, subclass 23.2.
- III. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 6A12, classified in class 536, subclass 23.2.
- IV. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 2A10, classified in class 536, subclass 23.2.
- V. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 9A3, classified in class 536, subclass 23.2.
- VI. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 19G8, classified in class 536, subclass 23.2.
- VII. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 15A10, classified in class 536, subclass 23.2.
- VIII. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 12H1, classified in class 536, subclass 23.2.
- IX. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 8G4G, classified in class 536, subclass 23.2.
- X. Claims 41-42, drawn to a nucleic acid encoding catalytic antibody 8G4E, classified in class 536, subclass 23.2.
- XI. Claims 45-48, drawn to a pharmaceutical composition for decreasing the concentration of cocaine and for treating cocaine overdose and a method for decreasing the concentration of cocaine and for treating a cocaine overdose, classified in class 424, subclass 175.1 and 94.1.

Art Unit: 1652

The inventions are distinct, each from the other because of the following reasons:

Group I and groups (II-X) are drawn to completely different chemical compounds that are patentably distinct.

Groups II-X are drawn to completely different nucleic acid molecules. A perusal of the specification does not indicate what SEQ ID NOs encode each of the 9 catalytic antibodies.

Inventions I and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as to degrade cocaine not related to medicinal treatment.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

It is noted that claims 1 and 21 would be subject to statutory double patenting rejections over claims 1 of U.S. Patents 5,948,658 and 6,280,987, respectively. If these claims were deleted or amended so as not to be subject to a double patenting rejection, the examiner would seriously consider


Art Unit: 1652

examining claims 43-48 together since claims 1 and 21 have been previously examined. If the nucleic acid sequences of the 9 catalytic antibodies are not in the instant specification, as noted *supra*, it is maintained that it would be impossible for the examiner to examine them. Furthermore, the claims would be subject to a 35 USC § 112 first paragraph rejection in that one of ordinary skill in the art would not know how to make the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone number is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
February 27, 2003